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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,591	07/01/2003	Jamieson William MacLean Crawford	P-3522/24C1	6153
26253	7590	07/09/2009		
David W. Hight, VP & Chief IP Counsel Becton, Dickinson and Company 1 Becton Drive MC 110 Franklin Lakes, NJ 07417-1880			EXAMINER DESENTO, MATTHEW F	
			ART UNIT 3763	PAPER NUMBER
			MAIL DATE 07/09/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/612,591	CRAWFORD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MATTHEW F. DESANTO	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 April 2009.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 17 and 23-25 is/are allowed.
- 6) Claim(s) 1-9, 11-16, 22 and 26 is/are rejected.
- 7) Claim(s) 10 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The 112 Rejections is withdrawn because of the amendments to the claims.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 11-16, 19, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szabo et al. (USPN 5,632,732) further in view of Bevilacqua (USPN 5,509,907).

4. Szabo et al. discloses a safety needle device with a shield (40+62) and a channel (72+45) mounted on said shield, and wherein the channel can be moved to different orientations on the shield. Szabo et al. fails to disclose the cannula finger lock.

5. Bevilacqua discloses a needle guard that has severe finger locks to secure the needle to the shield (figure 2, 4, 5, 10),

6. At the time of the invention it would have been obvious for one of ordinary skill in the art to combine the device of Szabo et al. with the teachings of Bevilacqua because Bevilacqua discloses an easy and effective way to secure the needle to the needle shield to prevent accidental pricking.

***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 1, 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, of U.S. Patent No. 7,220,249.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a needle shield device with a needle hub, a needle cannula, a shield and a locking assembly or channel.

***Allowable Subject Matter***

9. Claims 10, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 17, 23-25 are in condition for allowance.

***Response to Arguments***

11. Applicant's arguments filed 04/10/09 have been fully considered but they are not persuasive.

12. The examiner respectfully disagrees with the interpretation of the 103 Rejection. The examiner feels that Bevilacqua provides proper motivation and a benefit for adding a cannula finger lock to a needle shield since it would prevent the cannula from being accidentally released. One of ordinary skill in the art would understand that the cannula finger lock would provide an extra benefit to any needle shielding device that lacked such a structure (i.e. Szabo). The examiner also feels that the cannula lock wouldn't be redundant to the device of Szabo since the cannula lock would provide an extra locking element to ensure the needle is locked into the shield. The examiner further relies on MPEP and the recent KSR case when dealing with combining structural elements that are taught in the prior art. See MPEP section 2141 and ["In United States v. Adams, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." Id. at \_\_\_, 82 USPQ2d at 1395. (2) "In Anderson 's-Black Rock, Inc. v. Pavement Salvage Co., . . . [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation." Id. at \_\_\_, 82 USPQ2d at 1395. (3) "[I]n Sakraida v. AG Pro, Inc., the Court derived . . . the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is

obvious.”] MPEP section 21410.3 - “A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton.” KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1397 (2007). “[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” Id. Office personnel may also take into accounts “the inferences and creative steps that a person of ordinary skill in the art would employ.” Id. at \_\_\_, 82 USPQ2d at 1396.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW F. DESANTO whose telephone number is (571)272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew DeSanto  
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